

AMENDMENT UNDER 37 CFR § 1.111
Appln. No.: 10/028,914

REMARKS

The present invention relates to a substrate film for an adhesive sheet comprising an elastomer resin and a hydrophilic polymer having certain characteristics.

In the Office Action dated March 17, 2004, it is appreciated by Applicants that the Examiner recognized that the Advisory Action dated 2/25/04 was incorrect, and that certain earlier rejections were withdrawn. It is furthermore, appreciated by Applicants that the Examiner has accepted the Terminal Disclaimer that was filed January 30, 2004.

However, the specification was objected to with respect to a perceived inconsistency between the disclosure at page 4, lines 3-4 and at page 4, lines 15-16. Furthermore, claims 1-9, 17, and 18 were rejected under 35 U.S.C. § 1.112 first paragraph, with respect to enablement for substrate film comprising an “elastomer” and “hydrophilic polymer”. Lastly, claims 1-9 (and apparently claims 17 and 18?) were rejected under 35 U.S.C. § 103(a) based on US Patent 5,607,687 (Bezwada et al ‘687) in view of US Patent 4,541,426 (Webster ‘426).

Applicants have herein amended claim 1 in order to more clearly indicate the nature of the present invention, in which the substrate comprises elastomer and hydrophilic polymer that are mixed together to form a solution, and are then cast onto a releasable surface of sheet, thus forming a single layer substrate film.

With respect to the issues raised in the Office Action, first, regarding the objection, the Examiner has indicated an impression that there is an inconsistency between the disclosure at

AMENDMENT UNDER 37 CFR § 1.111
Appln. No.: 10/028,914

lines 3-4 of page 4 visa-a-vis lines 15-16 of page 4. As noted by the Examiner, the disclosure at lines 3-4 refers to the mixture of the elastomer resin and a polymer, and indicates as properties of the polymer that it is higher in elasticity than the elastomer resin, and that it has a water absorption ability. Of course, a water absorption ability is also described by the term “hydrophilic”. Therefore, Applicants would respectfully submit that the disclosure at lines 15-16 of a hydrophilic polymer having a tensile modulus of elasticity higher than that of the elastomer resin is not inconsistent, and has the same underlying meaning, although the precise words used are slightly different. Accordingly, it is respectfully submitted that there is no inconsistency, and no change is necessary in the disclosure at page 4. However, if the Examiner believes that some wording change would improve the clarity, the Examiner is invited to contact the undersigned attorney to discuss any change that the Examiner would recommend.

Turning to the rejection under 35 U.S.C. § 112, first paragraph, the test of enablement is whether one skilled in the art to which the invention pertains would be enabled to make and use the invention. Applicants respectfully submit that in the case of the present invention, one skilled in the art of the present invention would have a clear and definite idea of what is intended by the use of the term “elastomer” and the term “hydrophilic polymer” as used in the present specification and claims. That is, considering the general disclosure of the present specification as well as the specific working examples in the present specification, through the eyes of one skilled in this art, it is respectfully submitted that such person skilled in the art would be enabled to practice the present invention as broadly as is claimed. Therefore it is respectfully submitted that the claims in their present form fully comply with the requirements of 35 U.S.C. § 112.

AMENDMENT UNDER 37 CFR § 1.111
Appln. No.: 10/028,914

Lastly, turning to the rejection under 35 U.S.C. § 103(a), is again noted that independent claim 1 has been amended to further explicitly recite that the substrate film in the case of the present invention is a single layer substrate that is formed of an elastomer resin and a hydrophilic polymer, wherein the hydrophilic polymer has a tensile modulus of elasticity higher than that of the elastomer resin.

With respect to the Bezwada et al '687 and Webster '426 references, which are newly cited references, the Examiner has recognized that the Bezwada et al '687 reference is deficient as a reference in lacking express teaching that the hydrophilic polymer has tensile modulus higher than that of the elastomer resin and that the blend is suitable as a substrate for an adhesive sheet. However, the Examiner indicated an impression that the deficiencies of Bezwada et al '687 might be overcome by combining Webster '426 therewith, with the combined teachings allegedly providing for a wound dressing sheet motivated by Webster '426's desire to obtain a wound dressing which can be highly hydrated. However, the Examiner has also recognized further deficiencies of the combined references lacking express teaching, with respect to features recited in present claims 5, 7, and 9. Furthermore, claims 17 and 18 were not addressed in the 35 U.S.C. §103 rejection.

In addition to the foregoing deficiencies many of which have been recognized by the Examiner, Applicants note that the present invention is directed to a substrate film, as amended herein to explicitly recite a single layer substrate film, thus further differentiating over the cited prior art. That is, whereas the cited references disclose two-layered sheets, the present invention is directed to a single layer substrate.

AMENDMENT UNDER 37 CFR § 1.111
Appln. No.: 10/028,914

Accordingly, it is respectfully submitted that the rejection under 35 U.S.C. § 103(a) should now be withdrawn.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.

If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the local Washington, D.C. telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

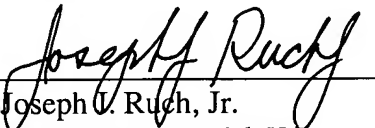
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